

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 13-18 and 21-23 are rejected under 35 U.S.C. 102 (b) over the patent to Haydon.

Claim 13 is rejected under 35 U.S.C. 102(b) over the patent to Brown.

The other claims are rejected over combinations of the references.

The Examiner indicated that he did not receive the information disclosure statement and rejected the claims under 35 U.S.C. 112.

In connection with the Examiner's request, a copy of the Information Disclosure Statement is submitted herewith.

In response to the Examiner's questions raised in paragraph 2 and 3 of the Office Action, the Examiner's attention is respectfully directed

BEST AVAILABLE COPY

to the paragraph bridging pages 3 and 4 of the specification. It is stated there that "The potentiometer 47 comprises at least one detent tooth 51 on its circumference, and the housing 5 has at least one detent projection 54, for example. When the potentiometer housing 47 is installed in the housing 5, the at least one detent tooth 51 and the at least one detent projection 54 form a detent toothing 57".

Also, Figure 2 clearly shows the construction of the detent tooth 51 on the potentiometer housing 47. It is believed that no changes are needed in the drawings. However, if in the Examiner's opinion some additional changes are necessary, even after the explanations presented herein above, applicants will be glad to submit a corresponding drawing.

Turning now to the Examiner's rejection of the claims over the art, in particular his statement on paragraph 10 of the Office Action, the Examiner indicated that in his opinion the expression "the housing "has" at least one detent projection 54" does not clearly specify the new features of the present invention. It is respectfully submitted that the drawings and the associated description in the present application clearly disclose that the detent elements are formed directly on the housings and not as the

Examiner indicated on any other parts and them eventually connected with the housing.

In paragraphs 4 and 5 of the Office Action the Examiner rejected the claims as being anticipated by the patent to Haydon.

As explained before, the potentiometer housing 16 in the device disclosed in the patent to Haydon does not have any detent tooth or detent teeth. A detent tooth is a means for operative connection between two cooperating components. Such a detent tooth is not provided on the potentiometer housing 16 of the device disclosed in the patent to Haydon and shown in Figure 1. Neither the element 54 nor the element 31 cited by the Examiner can be considered as a detent tooth. In applicant's opinion the Examiner's interpretation of the detent tooth is unjustifiably broad and can not be considered as acceptable. The Examiner stated "That is" has" is construed broadly when the elements are all attached indirectly". However even without additional clarification, it is believed to be clear that if a claim defines that a housing has an element, definitely this can not be interpreted that the device provided with a housing has a housing and an element which is located somewhere and cooperates with the housing through some intermediate elements. Even without stating that the element is directly

arranged on the housing, it is clear that when the housing has an element, the element is provided on the housing and not somewhere else.

Coming now more specifically to the construction disclosed in the patent to Haydon, it can be seen that the element 55 disclosed in the patent to Haydon is screwed on a plate 13. A screwing can not be considered as a detent toothing. A detent toothing with the potentiometer housing 16 is not provided in the patent to Haydon. The same is true for the arresting correction of the component 31 with the potentiometer housing 16. The component "gear" of the device disclosed in the patent to Haydon has a detent connection, if this can be interpreted so, with the toothed gears 28b. These toothed gears are however not components of the potentiometer housing 16, as can be seen from Figure 1. Also, the toothed gears 28b are not arranged on the housing 15 of the device disclosed in the patent to Haydon. The tooth gears 28b are mounted on a plate 27 which is connected with the shaft 26. Thereby the housing 15 has no detent teeth 28a or 28b, and in particular the housing 15 has no detent teeth which are in operative connection with the housing 16 of the potentiometer.

It should be emphasized that here a mounting of one housing on the other housing takes place. In other words, the housing inner surface

of the housing 5 comes to abutment against the housing outer surface of the potentiometer 25. Such a design is not disclosed in the patent to Haydon and can not be derived from it as a matter of obviousness.

Claim 13 specifically defines that "the potentiometer housing 47 has at least one detent tooth 51" and that "the housing 5 has at least one detent projection 54". These expressions define specific technical features, or in other words a design of the corresponding housing. They have nothing to do with a notion that inside a region surrounding the housing a detent tooth is provided, as the Examiner interpreted in a manner which is believed to be not acceptable. When the housing has an arresting tooth, this is the feature and the property of the housing. Such feature and property is not provided either in the housing 15 or in the potentiometer housing 16 of the device disclosed in the patent to Haydon.

It is believed to be clear that the patent to Haydon does not teach the new features of the present invention as defined in claim 13 and these features can not be derived from it as a matter of obviousness.

Nevertheless, applicants have submitted additional claim 24 (canceling claim 23 so as not to increase the number of claims after the

Final Office Action), which more specifically defines that the potentiometer housing 47 has at least one detent tooth 51 arranged directly on and formed of one piece therewith (the potentiometer housing 47), and that the housing 5 has at least one detent projection 54 arranged directly on and formed of a piece therewith (the housing 5). It is believed that claim 24 is more specific. However, it is not actually needed since claim 13, based on the above presented arguments, clearly and patentably distinguishes the present invention from the prior art. However, if in the Examiner's opinion a further clarification of claim 13 is desirable, it is respectfully requested to consider claim 24 and allow it, since the features of this claim clearly and patentably distinguish the present invention from the patent to Haydon.

Turning now to the Examiner's rejection of the claims over the patent to Brown, it is respectfully submitted that this reference does not disclose a potentiometer housing which has a detent tooth. In the device disclosed in the patent to Brown, there is no detent toothing between the potentiometer housing and the housing 12 of the device. The arguments presented in the patent to Haydon are completely applicable with respect to the patent to Brown. The applicant's invention deals with a detent toothing with corresponding detent teeth 51 and at least one detent projection 54. Such a detent toothing is provided in Figure 1 of the patent to Brown.

between the elements 56 and 57 and not between the housing 12 and the potentiometer 51. With respect to the patent to Brown, also the Examiner's opinion that the feature "that the housing has at least one detent projection 54" can be qualified as unpermissible broadening. It is believed that the patent to Brown also does not teach the new features of the present invention as defined in claim 13, and definitely does not teach the new features of the present invention as defined in claim 24.

The other references applied by the Examiner against the dependent claims have been also carefully considered. Since they do not teach the new features of the present invention as defined in claims 13 and 24, it is believed that the independent claims rejected over these references and containing the subject matter of claim 13 should also be considered as patentable.

The Examiner rejected the original claims as being anticipated over the patents to Haydon and Brown. In connection with this, applicants wish to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references do not disclose each and every element defined in claims 13 and 24, and therefore the anticipation rejection should be considered as not tenable with respect to claims 13 and 24 and should be withdrawn.

The obviousness rejection is supplied by the Examiner against some dependent claims. It is respectfully submitted that in order to arrive at the applicant's invention from the references as a matter of obviousness, a person of ordinary skill in the art would have to be fundamentally modify the constructions disclosed in the references, in particular by providing the corresponding detent elements on the corresponding housings. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *in re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, there is no hint or suggestion for such modifications.

In view of the above presented remarks and amendments, it is believed that claims 13 and 24 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 13, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the
undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.